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EXAMINER
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RETTA, YEHDEGA

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/687,499  
Filing Date: October 13, 2000  
Appellant(s): WINSLADE ET AL.

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Joseph F. Harding  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 15, 2011 appealing from the Office action mailed January 27, 2011.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 34-39 are pending.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

### **(8) Evidence Relied Upon**

6,915,271	MEYER et al.	7-2005
5,729,693	HOLDA-FLECK	3-1998
2002/0052778	MURPHY et al.	5-2002

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US 6,915,271).

Regarding claim 34, Meyer teaches offering by a second system of a second party (the service provider that runs the incentive system) items for sale at a sales price amount (items that are sold at the websites) wherein the item for sale can be identified

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by a customer using the second system (the incentive system website where the merchants sites such as Target, Holt, EB, amazon.com etc, circuit city are included (see fig. 31-35, col. 16 lines 1-5, col. 39 line 55 to col. 41 line 22); providing, *by the second system*, a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale ( promotions from Target or Holt or amazon.com etc.,) (see fig. 31 and col. 16 lines 6-67, see col. 38 line 60 to col. 40 line 67; wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount (fig. 19-34, col. 45 lines 19-44); receiving, by the second system (service provider or the incentive system), online purchase request from customer for at least one item (buy now) (see col. 40 line 64 to col. 41 line 40); responding, by the second system, to the online purchase request by collecting from the customer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 41 line 66 to col. 42 line 25) and electronically communicating, by the second system to the first system, an indication regarding the collection from the customer of the purchase amount (see col. 40 line 64 to col. 41 line 40, col. 42 line 1-64, col. 49 lines 40 to col. 50 line 7).

Regarding claim 35, Meyer teaches offering, by a second system of a second party, an item for sale online at a sales price amount (see fig. 33 and 35 also col. 40 line 64 to col. 41 line 40), the item for sale having associated with it, by the second system of the second party, a promotion from the first party, the promotion having a promotion amount *wherein the second system is distinct from the first system and the second*

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*party is distinct for the first part* ((see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36) responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 42 lines 1-36); and causing, by the second system, shipment by the second party of the item for sale to the buyer (see col. 41 lines 22-40).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Murphy et al. (US 2002/0052778 A1).

Regarding claims 36-38, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site))(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by

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the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the buyer, it is taught in Murphy (see [0015]-[0018]). It would have been obvious to one of ordinary skill in the art at the time of the invention to collect fee from the buyer as in Murphy in order to demonstrate the user's level of interest to the manufacturer or charge for the service provided by the second party.

Claims 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Holda-Fleck (US 5,729,693).

Regarding claims 36 and 39, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site))(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount

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corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the first system, it is taught in Holda-Fleck (see col. 3 lines 23-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to collect fee from the first party, as in Holda-Fleck, in order to charge for the service provided by the second party, as taught in Holda-Fleck.

#### **(10) Response to Argument**

Regarding claim 34, Meyers teaches an incentive issuer as a merchant or manufacturer of goods or services ... that desires to promote its products or services by offering incentive... (col. 16 lines 1-5) ... a promotion agency would select service provider to use for the promotional campaign ... an incentive issuer may run a promotion without using a third party... for example, a merchant such as CIRCUIT CITY may issue a set of promotions related to goods sold at its store, and act as the sponsor of the promotion ... (see col. 16 lines 48-67). Meyers teaches displaying a portal including a plurality of promotions (incentive) wherein a customer can search for incentives associated with items for sale. Meyers teaches items for sale (see fig. 19 and 20), for example, the Sony Camcorder is an item for sale offered by the second system. The portal also includes promotion provided by a first party (merchant or manufacture). The customer is aware of the items for sale at the second system before searching for the promotions.

Appellant argues that "the relied upon "service provider" of Meyer does not, however, teach such "providing, by the second system, a portal containing a plurality of

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promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system ... " Instead, Meyer teaches a Buy Now feature where any purported "promotion" is known before an item for sale is identified". Further Appellant argues that such a feature cannot teach anything with respect to a search for a promotion **after an item for sale is identified**, because in Meyer any such "incentive" is already known and the Office Action offers no explanation for how or why Meyer teaches such a search for an incentive (or why a portal for such a search would be provided) after identifying an item for purchase, **when it was the incentive itself from which the consumer was originally directed to the item for purchase in the first place.**

The claim merely recites offering items for sale online and providing portal containing a plurality of promotions.

As indicated before, the claim does not recite that the customer first selects the item for purchase at the second system and after the customer selected the item for purchase then searches for a promotion from the first party. The claim recites providing, by the second system, a portal containing a plurality of promotions ***wherein the customer can search for a promotion*** from the first party associated with the item for sale, *wherein the customer can search for the promotion after the customer has identified the item for sale on the second system*, the promotion having a promotion amount. Even though the claim recites that the customer can search the promotion it does not include the step of searching nor does it include the step of identifying the item

for sale. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). The claim also does not identify the first party being different from the second party.

Regarding the phrase “the customer has identified the item”, claims are to be given their broadest reasonable interpretation in light of the supporting disclosure. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. (see MPEP 2111)]

Appellant’s specification (see pp 15) teaches as follows:

In another exemplary scenario, the online using the personal computer 5 accesses the Internet via a connection 30 employing a modem on his computer and a browser software on his computer. He then, using his browser software navigates to a manufacturer/merchant environment 25, such as an electronic mall, purchase one or more items of his choice. A connection 50 established over the Internet between the computer 5 and the manufacturer/merchant environment 25 allows user selection of purchasable items, optionally via a catalog of items presented to the customer by the manufacturer/merchant environment 25. ***After selecting the desired items into a shopping cart, the invokes a rebate and coupon button on a screen presented by the manufacturer/environment 25 that results in the submission of the shopping cart to the system 15 via a connection 45. In response, the system 15 selectively returns all applicable coupons to each of items in the customers shopping cart.*** This includes manufacturer's coupons, retailer's coupons etc. In addition, ***if any items in the shopping cart are not specific enough to unambiguously identify a manufacturer, the system 15 returns coupons for multiple manufacturers of similar products for the customer to***

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***choose from. The returned rebates and coupons are automatically applied by the manufacturer/merchant environment 25 in the I determination and display of a final price for the customer. |***

Appellant did not provide explicit definition for the term “identified”.

Therefore, the plan meaning of the word “identified” includes “known”, “recognized”, “acknowledged”.

Regarding Appellant's argument that “Meyer does not teach anything with respect to searching for a promotion after the identification on the second system, let alone “providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system...”, Examiner points out that the claim does not recite that the item for sale is offered first, the customer “identifies” the item for sale and then the portal is displaying. The claim merely recites offering item for sale and providing a portal containing the promotion. Appellants assertion that the “wherein the customer can search...” clause describes the providing of the portal, so that such a portal must be provided after the identification of the item for sale so that the customer can search after identifying the item for sale. (Also, the claim requires such an identification to be on the second system.) The claim plainly recites “providing by the second system a portal...wherein the customer can search for the promotion after the customer has identified the item for sale.” it follows that

for the customer to search the portal after the customer has identified the item for sale, the portal is provided after the item has been identified for sale”, Examiner points out that the customer can make such an identification of the item for sale by viewing the items displayed by the incentive provider (which also include incentive). The customer searches for the item to purchase by searching the item which also includes the incentive.

Regarding claim 35, Appellant argues that in Meyer the purported "second party" does not ship ... instead, information is provided to the vendor, and the vendor ships. Examiner points out that in Meyer's the first and second party can be the same (see col. 16 lines 1-67). Appellant's claim does not recite that the second party is different than the first party.

Regarding claim 36, Meyer teaches an incentive issuer is typically the merchant or manufacturer of goods or services, for example, SONY, or CIRCUIT CITY or MARIOT HOTLES etc., that desires to promote its products or services by offering incentives and a promotional agency is an entity retained by the incentive issuer to carry out a promotion campaign; in other embodiment, the incentive issuer may act as its own promotion agency. Meyer also teaches that the incentive issuer may run a promotion without using a third party (the sponsor is the issuer) for example, a merchant such as CIRCUIT CITY. Therefore, if the sponsor is the merchant, the products or items for sale are acquired from the manufacturers. If the sponsor is the third party, the products are acquired from the merchants since the products are sold at the third party (incentive site). Meyer also teaches that when the "Buy Now" button is pressed from any incentive

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display, including a clipped incentive or an unclipped incentive, a member may go to the site on the a Web for purchasing the goods or services, which may be the same site one is on, or at a different Web location, or corresponding to an offline merchant that does not have a Web site.

Appellant argues that the "service fee" of Murphy is not collected by the second system (that offers the item for sale online). Appellant further argues that the fee in Murphy is collected by a website operator, but the incentive is used when buying a product neither purchased from the website operator, nor even purchased online, as Murphy discusses an automobile purchase at a dealership. Examiner would like to point out that Murphy teaches a web site including a central site incentive program server 22, a manufacture (or other incentive issuers), and a retail (or other redemption) facilities (see [0074])... the central server 22 which receives and stores the user incentive information charges the users a fee (see [0090]-[0094]. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding claim 39 Appellant argues that the service charge in Holda-Fleck is not collected by the "second party" as set forth in the Claim 36. Appellant asserts that the service fee in Claim 36 is "associated with an online purchase request."; in contrast, the service provider of the cited portion of Holda-Fleck is not even accessed until after an item is purchased.

Holda-Fleck was relied upon for the teaching of collecting a fee from a first party by a second party not for the teaching of online purchase request. The claim was rejected under "103" not "102". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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